

## REMARKS

This Response is submitted in reply to the Office Action dated September 22, 2008. Claims 1, 6, 8, 9, 14, 15, 16, 18, 21, 23, and 25 have been amended. No new matter has been added by these amendments. Please charge deposit account 02-1818 for any fees which are due in connection with this Response.

The Office Action rejected Claims 1 to 4, 6, 9 to 12, 14, 21, 22, and 25 under 35 U.S.C. 102(b) as being anticipated by WO 98/09259 to Bennett in view of U.S. Patent No. 6,174,235 to Walker et al. (hereafter Walker).

Bennett discloses a gaming device that provides a tic-tac-toe based game. The gaming device includes a plurality of selectable zones and prizes associated with at least one of the zones. The gaming device enables the player and gaming device to alternate selecting unselected zones. Player selected zones are indicated with a player marker (e.g., an "X") and gaming device selected zones are indicated by a gaming device marker (e.g., an "O"). The gaming device displays a prize in a selected zone if a prize is associated with the selected zone. The player wins the game by selecting three zones in a straight line. If the player wins the game, the gaming device determines the player's award from the sum of any of the prizes in the player's selected zone multiplied by the number of units wagered. In certain versions of Bennett, the gaming device will associate some zones with a zero prize value.

Walker discloses:

[a]n electronic gaming device defines a set of all possible elements of a game. For example, in a slot machine-type game, the set of possible elements includes the symbols for cherries, bell, bar, orange, plum and seven. The gaming device further generates a set of location assignments for each of the elements, and assigns a location to each element in accordance with the set of location assignments. The player is presented with the locations and prompted to select one or more locations, depending on the type of game. The displayed locations to select are typically arranged in one or more rows of possible selections. Typically, each of the possible selections is hidden or obscured until selected by the player. The player provides his selection(s), and at least one corresponding selection signal(s) are received by the gaming device. Each received selection signal indicates an element from the set of possible elements. The selected elements are displayed, either after each selection is made or

after all selections are made. The gaming device evaluates an outcome of the game in accordance with the selected elements. Depending on the type of game, the outcome may or may not be based on the order in which the elements are selected. Since the player selects the elements, he is provided with an illusion of control over the outcome of the game.

Column 9, lines 18 to 26 of Walker discloses that:

[r]eferring to FIG. 10, another embodiment of the present invention is described. Groups 300, 302 and 304 of possible selections are displayed, each set including all possible elements. The player selects at least one element from each of the groups 300, 302 and 304. For example, in a slot machine-type game, one symbol would be selected from each group, yielding three selected symbols. The outcome of the game would, in turn, be evaluated in accordance with the three selected symbols.

Amended independent claim 1 is directed to a gaming device that includes a display device, an input device, and a processor in communication with the display device and the input device. The processor is programmed, for each play of a game, to: (a) cause a plurality of masked selections to be displayed to a player by the display device, (b) associate a plurality of different values with the masked selections prior to the masked selections being picked by the player and without displaying which values are associated with which selections, (c) enable the player to pick a plurality of the masked selections for a designated number of predetermined sets, the designated number being at least two, (d) for each of the designated number of predetermined sets, determine a plurality of the values in the set by enabling the player to pick a plurality of the selections for the set, wherein the plurality of values in each set are based on the values associated with the selections picked by the player for the set, (e) cause a display of each of the predetermined sets and the values in each set, (f) generate at least one award by selecting, for each one of the predetermined sets and regardless of an amount of any of the values, at least one but not all of the plurality of values associated with the selections picked by the player in the predetermined set, and (g) provide the award to the player.

Applicant submits that Bennett and Walker individually, and the gaming device resulting from the combination of Bennett and Walker, do not disclose a gaming device

that includes a processor programmed, for each play of a game, to: generate at least one award by selecting, for each one of the predetermined sets and regardless of an amount of any of the values, at least one but not all of the plurality of values associated with the selections picked by the player in the predetermined set.

The Office Action relied on Bennett to disclose a gaming device that generates at least one award by selecting, for each one of the predetermined sets, at least one but not all of the plurality of the values in the predetermined set. Specifically, pages 4 to 5 of the Office Action stated that:

[t]he Examiner notes that the invention as claimed required that at least one but less than all of the total number of values in each set be used to generate an award... As such, Bennett clearly teaches such because the player is only awarded those credits earned by his selections and not those of the gaming device.

In other words, the Office Action appears to have interpreted both the player's selections and the gaming device's selections in the tic-tac-toe game of the gaming device of Bennett as forming a predetermined set of the gaming device of independent claim 1.

Applicant respectfully disagrees and submits that Bennett does not disclose a gaming device that includes a processor programmed, for each play of a game, to: generate at least one award by selecting, for each one of the predetermined sets and regardless of an amount of any of the values, at least one but not all of the plurality of values associated with the selections picked by the player in the predetermined set. In Bennett, the gaming device selects all of the values associated with all of the player's selections to generate the player's award if the player wins the game. That is, in Bennett, none of the player's selections are excluded when the gaming device calculates the player's award. The gaming device of Bennett therefore does not select at least one but not all of the plurality of values associated with the selections picked by the player in any predetermined set. On the other hand, the gaming device of amended independent claim 1 includes, amongst other elements, a processor programmed to, for each play of a game, to: generate at least one award by selecting, for each one of the predetermined sets and regardless of an amount of any of the values, at least one but

not all of the plurality of values associated with the selections picked by the player in the predetermined sets.

The Office Action alternatively reasons that Bennett discloses a gaming device that generates at least one award by selecting, for each one of the predetermined sets, at least one but not all of the plurality of values in the predetermined set because Bennett enables a player to select zero prize values. Specifically, page 5 of the Office Action stated that:

selections bearing a prize are selected (e.g. 5 credits), whereas "zero prize" zones are not used to generate the awards(s); see at least p.2, ll.17-19.

Applicant respectfully disagrees and submits as previously stated in the Response to Office Action dated June 30, 2008, the Office Action's interpretation of a zero prize value selection in the game of Bennett as selecting, for each one of the predetermined sets, at least one but not all of the plurality of values in the predetermined set of the gaming device of amended independent claim 1 is not proper. The Office Action reasons that in Bennett, if a player selects a plurality of values including a value of zero and the plurality of values are summed to produce a total award value, the zero value does not affect the total award value. That is, a selected zero value in the gaming device of Bennett produces the same award value as generating at least one award by selecting, for each one of the predetermined sets, at least one but not all of the plurality of values in the predetermined set of the gaming device of amended independent claim 1. However, based on the Office Action's reasoning, Bennett determines the award by summing all of the player's selected values (i.e., including the zero value).

Moreover, if the player's selections do not include a zero value in the game of Bennett, the Office Action's interpretation of the game of Bennett fails because the sum of all of the player's selected values of Bennett will produce an award value that is different from an award determined by selecting, for each one of the predetermined sets and regardless of an amount of any of the values, at least one but not all of the plurality of values associated with the selections picked by the player in the predetermined set,

for each play of a game. For example, if the player in the gaming device of Bennett selected three zones that are each associated with 5 credits and the player wins the game, the player wins an award of 15 credits (i.e., the sum of the player's selected zones). On the other hand, if the player selected three zones wherein two of the selected zones are associated with 5 credits and one zone is associated with 0 credits and the player wins the game, the player wins an award of 10 credits (i.e., the sum of the player's selected zones). In other words, based on the Office Action's reasoning, Bennett does not for each play of the game, generate at least one award by selecting, for each one of the predetermined sets and regardless of an amount of any of the values, at least one but not all of the plurality of values associated with the selections picked by the player in the predetermined set because Bennett does not always provide an award of zero credits to a player.

Walker also does not disclose a gaming device that generates at least one award by selecting, for each one of the predetermined sets and regardless of an amount of any of the values, at least one but not all of the plurality of values associated with the selections picked by the player in the predetermined set. Accordingly, Applicant submits that the gaming device resulting from the combination of Bennett and Walker does not disclose a gaming device that includes a processor programmed, for each play of a game, to: generate at least one award by selecting, for each one of the predetermined sets and regardless of an amount of any of the values, at least one but not all of the plurality of values associated with the selections picked by the player in the predetermined set. Moreover, it would not have been obvious to modify Bennett and Walker to result in such a gaming device without being construed as impermissible hindsight reconstruction. On the other hand, the gaming device of amended independent claim 1 includes, amongst other elements, a processor programmed, for each play of a game, to: generate at least one award by selecting, for each one of the predetermined sets and regardless of an amount of any of the values, at least one but not all of the plurality of values associated with the selections picked by the player in the predetermined set. For at least these reasons, Applicant submits that amended

independent claim 1 is patentably distinguished over Bennett in view of Walker and is in condition for allowance.

Claims 2 to 4 depend directly from amended independent claim 1 and are also allowable for the reasons given with respect to amended independent claim 1 and because of the additional features recited in these claims.

The gaming devices of amended independent claims 6, 9, 14, 21, and 25 each includes certain elements similar to certain elements of amended independent claim 1. For reasons similar to the reasoning discussed above with respect to amended independent claim 1, amended independent claims 6, 9, 14, 21, and 25 (and dependent claims 10 to 12 and 22 respectively) are each patentably distinguished over Bennett in view of Walker and are in condition for allowance.

Amended independent claim 21 is directed to a gaming device that also includes, amongst other elements, a processor programmed, for each play of a game, to: display a plurality of masked selections, wherein the masked selections are associated with a plurality of values prior to the masked selections being picked by the player and without displaying which values are associated with which selections, and wherein the associated values are each greater than zero.

Page 6 of the Office Action stated that:

the combination of Bennett and Walker teaches the invention as described above, but lacks in explicitly stating that each of the associated values is greater than zero. Such a limitation lacks criticality in the invention, as evidenced by the fact that all prior and numerous existing claims make no mention of the particular values to be assigned to each selection.

The Office Action concluded that a gaming device wherein the associated values are each greater than zero is therefore an obvious matter of design choice and does not change the operation of Bennett.

Applicant submits as previously stated in the Response to Office Action of June 30, 2008, Bennett does not disclose a gaming device that includes a processor programmed, for each play of a game, to: display a plurality of masked selections, wherein the masked selections are associated with a plurality of values prior to the masked selections being picked by the player and without displaying which values are

associated with which selections, and wherein the associated values are each greater than zero. In Bennett, some of the zones are associated with zero prize values. Thus, in Bennett, each of the plurality of zones is not associated with values that are greater than zero. On the other hand, the gaming device of amended independent claim 21 includes, amongst other elements, a processor programmed, for each play of a game, to: display a plurality of masked selections, wherein the masked selections are associated with a plurality of values prior to the masked selections being picked by the player and without displaying which values are associated with which selections, and wherein the associated values are each greater than zero.

Applicant also submits that a gaming device that includes: a processor programmed, for each play of a game, to: display a plurality of masked selections, wherein the masked selections are associated with a plurality of values prior to the masked selections being picked by the player and without displaying which values are associated with which selections, and wherein the associated values are each greater than zero is substantially more than a simple design choice.

Based on the MPEP guidelines for asserting design choice, it is not appropriate for the Office Action to assert that associating different values with selections in the gaming device of amended independent claim 21 is a design choice if the claimed invention functions differently from the prior art. For example, the MPEP §2144.04(I) states that a feature that is merely an aesthetic design change does not distinguish from prior art if the claimed features relate to ornamentation and not to function (citing In re Seid, 161 F.2d 229 (CCPA 1947)). The MPEP §2144.04(VI)(C) also states that a rearrangement of parts may be an obvious matter of design choice where moving a feature of an invention would not have modified the operation of the device (citing In re Japikse, 181 F.2d 1019 (CCPA 1950)).

Associating values greater than zero with each selection is not an aesthetic or an ornamental change to the gaming device resulting from Bennett in view of Walker. Moreover, associating values greater than zero with each selection is not a rearrangement of the parts of the gaming device resulting from Bennett in view of Walker that would not modify the operation of Bennett in view of Walker. Rather, such

elements pertain to the functionality of how the gaming device determines the player's award (i.e., the player must obtain a selection associated with a zero value in Bennett (in view of Walker) based on the Office Action's rationale as discussed above). Thus, the Office Action's acknowledgement that Bennett in view of Walker does not disclose a processor programmed, for each play of a game, to: display a plurality of masked selections, wherein the masked selections are associated with a plurality of values prior to the masked selections being picked by the player and without displaying which values are associated with which selections, and wherein the associated values are each greater than zero prevents any finding or conclusions that such functional differences are merely a design choice under the MPEP guidelines. Accordingly, the Office Action's conclusions of obvious design choice cannot properly form the basis of this rejection.

Moreover, Applicant submits that it is improper for the Office Action to contend that prior art references do not disclose certain claimed elements and then simply state that these claimed elements are a simple design variation. Without providing any reference which discloses these claimed elements, any conclusions that such claimed elements are a simple design choice is impermissible. As stated in In re Chu, 66 F.3d 292, the finding of In re Gal, 980 F.2d 717 is that 'obvious design choice' is precluded where the claimed structure and the function it performs are different from the prior art.

The Office Action rejected claims 8, 15 to 20, 23, and 24 under 35 U.S.C. 103(a) as being anticipated by Bennett in view of Walker and further in view of U.S. Patent No. 6,345,824 to Selitzky.

The Office Action stated that Bennett (in view of Walker) does not disclose selecting at least one but not all of the awards from the plurality of different sets in order to generate a resulting award. The Office Action relied on Selitzky to disclose a game with a bonus feature wherein if the player's hand includes more than one bonus combination, only the highest ranking bonus combination is rewarded. The Office Action concluded that it would have been obvious to one of ordinary skill in the art to apply "only awarding the highest ranking bonus combination" as disclosed in Selitzky



into the gaming device of Bennett (in view of Walker) to provide more frequent, but smaller awards in Bennett (in view of Walker) without the need to pay large awards.

The gaming devices of amended independent claims 8 and 23 each includes certain elements similar to certain elements of amended independent claim 21. Applicant submits that regardless of whether or not it would have been obvious to incorporate Selitzky with Bennett and Walker, the gaming device resulting from the combination of Bennett, Walker, and Selitzky discloses a gaming device wherein each of the plurality of zones are not associated with values that are greater than zero. Thus, for reasons similar to the reasoning discussed above with respect to amended independent claim 21, amended independent claims 8 and 23 (and dependent claim 24) are each patentably distinguished over Bennett in view of Walker and further in view of Selitzky and are in condition for allowance.

The gaming devices of amended independent claims 8, 15, 16, 18, and 23 each includes certain elements similar to certain elements of amended independent claim 1. Applicant submits that regardless of whether or not it would have been obvious to incorporate Selitzky with Bennett and Walker, the gaming device resulting from the combination of Bennett, Walker, and Selitzky does not disclose a gaming device that includes a processor programmed, for each play of a game, to: generate at least one award by selecting, for each one of the predetermined sets and regardless of an amount of any of the values, at least one but not all of the plurality of values associated with the selections picked by the player in the predetermined set as discussed above. Thus, for reasons similar to the reasoning discussed above with respect to amended independent claim 1, amended independent claims 8, 15, 16, 18, and 23 (and dependent claims 17 and 19 to 20) are each patentably distinguished over Bennett in view of Walker and further in view of Selitzky and are in condition for allowance.

The Office Action rejected claim 7 under 35 U.S.C. 103(a) as being anticipated by Bennett in view of Walker and further in view of Official Notice.

The Office Action stated that Bennett (in view of Walker) does not disclose that the display device displays selections and reveals values associated with the selections that are not picked by the player. The Office Action relied on Official Notice to disclose

that "it was notoriously well known in the art at the time of invention to display the non-chosen values, in addition to the chosen values." The Office Action concluded that one of ordinary skill in the art at the time of the invention would have been motivated to do so in order to indicate to the player what could have been selected.

Applicant submits that regardless of whether it was well known in the art at the time to display the non-chosen values, in addition to the chosen values, Bennett (in view of Walker) does not disclose a processor programmed, for each play of a game, to: generate a plurality of awards, by selecting, for each one of the predetermined sets and regardless of an amount of any of the values, a plurality of but not all of the values associated with the selections picked by the player in the predetermined set. Moreover, it would not have been obvious to one of ordinary skill in the art to modify Bennett in view of Walker and Official Notice to result in such a gaming device without reasonably being construed as improper hindsight reconstruction. On the other hand the gaming device of claim 7 includes, amongst other elements, a processor programmed, for each play of a game, to: generate a plurality of awards, by selecting, for each one of the predetermined sets and regardless of an amount of any of the values, a plurality of but not all of the values associated with the selections picked by the player in the predetermined set. Accordingly, for this reason and the reasoning provided with respect to independent claim 6, Applicant respectfully submits that claim 7 is patentably distinguished over Bennett in view of Walker and further in view of Official Notice and is in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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